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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Steven N. Terranova

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EXAMINER

BANGACHON, WILLIAM L

ART UNIT

PAPER NUMBER

2635

18

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,189

Applicant(s)

TERRANOVA, STEVEN N.

Examiner

William Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-10, 13-28 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10, 13-28 and 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Arguments***

1. Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's argument that Randelman does not suggest “**a transaction guideline or limitation indicating whether the customer can purchase an item or service presented for purchase**” (page 8, last paragraph), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Randelman et al teaches of “**determining whether services are authorized for a given vehicle**” {Randelman, col. 1, lines 65-66; col. 8, lines 1-2, lines 51-52}, and teaches of “**validating and invalidating a transaction by a customer**” {col. 4, lines 40-55} such as fuel filling, purchasing products {col. 1, lines 6-24; paragraph bridging cols. 1 and 2}.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “**Attempts to circumvent the guidelines or limitations will**

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preferably result in a message to the customer or operator that the item or service presented for purchase is not available to that particular customer... These guidelines and limitations may affect both fueling and non-fueling transactions" {page 8, 4th paragraph}) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the claims are broader than what applicant argues.

Finally, the examiner respectfully traverses applicant arguments that **"Randelman does not teach transaction limitations or guidelines that prevent carrying out of the transaction because the system of Randelman is only used for validation of credit or billing information used to pay for purchases"** (page 8, last paragraph). In this case, the accounting record in the system of Randelman not only contains billing information but also contains **"authorized purchases or products"** {col. 5, lines 62-65} and customer preferred product choices {col. 6, lines 3-6}. Further, Randelman teach of **"determining whether services are authorized for a given vehicle"** (equivalent to **"a transaction guideline indicating whether the customer can purchase an item or service presented for purchase"** as claimed) based on its accounting record {Randelman, col. 1, lines 65-66; col. 8, lines 1-2, lines 51-52}. And, Randelman teaches of validating and invalidating a transaction by a customer {col. 4, lines 40-55} such as fuel filling, purchasing products {col. 1, lines 6-24; paragraph bridging cols. 1 and 2}. Clearly, if a certain customer

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wishes to purchase fuel but is not authorized, then fuel will not be provided to the customer {FIG. 3, step 34}. And clearly, if a vehicle is not authorized to purchase a certain product according to its accounting record, then the computer will not further carryout the transaction. Randelman suggests that these features are beneficial for purchases that are billed against a fleet of group of vehicles rather than an individual {col. 7, lines 42-45}.

2. Applicant's arguments with respect to claims 1-3, 6-10, 13-28, and 34-38, have been considered but are moot in view of the new ground(s) of rejection.

For these reasons, rejection to the claims is maintained in this Office action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-3, 6-10, 13-26 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,072,380 (Randelman et al).

Regarding claims 1-3 and 9-10, Randelman et al teach of a system for providing transaction parameters for a customer's purchase of an item or service in association with a remote communication unit (8) which comprises a wireless communication electronics (2) adapted to receive signals including indicia/vehicle identity from remote communication units (8) {col. 2, lines 16-29}; a transaction interface (7) for carry out transactions {col. 4, lines 19-25; col. 7, lines 21-31}; a control system and memory (6) associated with said communication electronics (2) and said transaction interface (7) {col. 3, lines 13-29}; and said control system (6) adapted to receive the indicia from a remote communication unit and control a transaction at the transaction interface (7) involving the remote communication unit (8) according to predefined parameters defining a limitation or guideline for the transaction associated with the remote communication unit (8) {col. 1, line 26-col. 2, line 2; col. 4, lines 19-65; col. 6, lines 3-6; col. 7, lines 46-52}. Validating and/or invalidating a transaction (controlling a transaction) based on customer preferences (according to predefined parameters defining a limitation or guideline for the transaction) {col. 4, lines 40-55} stored in the card (associated with the

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remote communication unit) {col. 6, lines 3-6} and sent to the transaction interface {col. 4, lines 14-25; col. 7, lines 21-32};

Randelman does not disclose expressly "said control system will not further carryout the transaction if the transaction does not conform to the transaction guideline or limitation". However, Randelman teaches of validating and invalidating credit which includes verifying authorized operators {col. 4, lines 40-55} with regards to fuel filling or purchasing products {col. 1, lines 6-24; paragraph bridging cols. 1 and 2}. Clearly, if a customer wishes to purchase fuel but is not an authorized operator, then fuel will not be provided to the customer {FIG. 3, step 34}. And clearly, if a vehicle is not authorized to purchase a certain product according to its accounting record, then the control system will not further carryout the transaction. Randelman suggests that these features are beneficial for purchases that are billed against a fleet of group of vehicles rather than an individual {col. 7, lines 42-45}.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a control system that will not carryout a transaction if the transaction does not conform to the transaction guideline or limitation in the system of Randelman, as claimed, because if a vehicle wishes to purchase fuel but is not authorized, then fuel will not be provided to the vehicle.

With regards to claims 6-8, although Randelman does not disclose expressly "the predefined parameters limit a transaction to a purchase amount and control a transaction by preventing purchase of select product", these claim

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limitations would have been obvious in the system of Randelman, to one of ordinary skill in the art {col. 4, lines 19-59; col. 7, lines 32-52}. The remote communication units (8) are cross checked for credit or other billing information as soon as it is determined that the remote communication unit is a valid customer {col. 4, lines 40-42}. The remote communication units provide accounting record containing all data needed for billing, discounts, and **authorized purchases or products** {col. 5, lines 62-65}. Clearly, this implies that the control system can limit a transaction to a purchase amount (**authorized purchases**) and/or control a transaction by preventing purchase of select products (**authorized products**). Limiting a purchase or product is provided in the CPF which stores customer preferred product choices, service appointment times, accounting, or payment methods {col. 6, lines 6-8}. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to "limit a transaction to a purchase amount and control a transaction by preventing purchase of select product" as claimed, in the system of Randelman, as described above, to one of ordinary skill in the art.

In claims 13, 14, 15, the system of claim 1 wherein said control system is connected to a network having said memory containing the predefined parameters {col. 5, lines 18-29}.

In claims 16-19, the system of claim 1 further comprising means for alerting a customer of a predefined parameter associated with said control

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system; wherein said control system is adapted cause said means to alert the customer when a predefined parameter is reached during a transaction; wherein said control system is adapted to cause said means to alert the customer that a predefined parameter exists; wherein said control system is adapted to monitor a transaction for actions violating the predefined parameters and cause said means to alert the customer of an action violating the predefined parameters {col. 4, lines 60-65; paragraph bridging cols. 5 and 6}.

In claims 20-24, the system of claim 1 further comprising means for alerting an operator of a predefined parameter associated with said control system; wherein said control system is adapted to cause said means to alert the operator when a predefined parameter is reached during a transaction; wherein said control system is adapted cause said means to alert the operator that a predefined parameter exists; wherein said control system is adapted to monitor a transaction for actions violating the predefined parameters and cause said means to alert the operator of an action violating the predefined parameters {col. 4, lines 14-19 and lines 44-51; col. 5, lines 18-29}

In claims 25-26, said means is display {col. 7, lines 21-32}.

Claims 34-38 recites to a method for practicing the system of claim 1 and its independent claims and therefore rejected for the same reasons.

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6. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,072,380 (Randelman et al) in view of US 5,798,931 (Kaehler).

In claims 27-28, Randelman does not disclose said means is an audio system and speaker. These claim limitations are conventional and widely used in gas stations. Most if not all gas stations that are open 24 hours use audio system and speaker to communicate with their customers, especially at night, for fear of theft/hold-up wherein the doors are locked, with just the attendant inside the store. Clearly, having an audio system and speaker in the system of Randelman is beneficial in avoiding theft/holdup. An example of such a system would be the operator intercom system of Kaehler. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have an audio system and speaker in the system of Randelman because this provides deterrence to theft or holdup.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,340,969 (Cox) is cited in that it teaches of a method and apparatus for approving card-based transactions {see whole document}.

Examiner Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon
Examiner
Art Unit 2635

August 5, 2004



BRIAN ZIMMERMAN
PRIMARY EXAMINER